

RECEIVED  
CENTRAL FAX CENTER

AUG 25 2006

MARSHALL, GERSTEIN & BORUN LLP  
ATTORNEYS AT LAW  
6300 SEARS TOWER  
233 SOUTH WACKER DRIVE  
CHICAGO, ILLINOIS 60606-6357  
(312) 474-6300  
FAX: (312) 474-0448

08/25/2006

FACSIMILE TRANSMISSION SHEET

TO: Examiner William L. Bangachon

U.S.P.T.O.

(571) 273-8300

FROM: Aaron M. Peters

RE:

PAGES (INCLUDING THIS PAGE): 7

\*\*\*\*\*

U.S.S.N.: 10/820,586

*If you do not receive all pages of this fax in good condition, please contact Amy Gawlik at (312) 474-6300.*

\*\*\*\*\*

*This transmission contains confidential information intended only for the addressee. If you are not the addressee, any disclosure or use of this information by you is strictly prohibited. If you have received this facsimile in error, please notify us by telephone immediately.*

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE RECEIVED  
CENTRAL FAX CENTER

Applicants: MAYER et al.

Serial No.: 10/820,586

Title: Electronic Device for Packet Boxes  
and Related Operating Method

Filed: April 8, 2004

Group Art Unit: 2612

Examiner: Bangachon, William L.

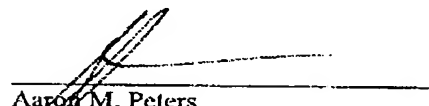
Atty. Docket Number: 30882/DP008

Customer No.: 04743

Confirmation No.: 8111

) I hereby certify that this paper and the  
) documents referred to as enclosed therewith  
) is being facsimile transmitted to the U.S.  
) Patent and Trademark Office, facsimile no.  
) (571) 273-8300 on the date indicated:

August 25, 2006.

  
Aaron M. Peters  
Registration No. 48,801  
Attorney for Applicants

PETITION TO WITHDRAW HOLDING OF FINALITY OF FINAL REJECTION  
DATED JUNE 26, 2006

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

The applicants respectfully request that the holding of finality of the official action dated June 26, 2006, be withdrawn. This request and petition is being timely filed under 37 C.F.R. 1.181 and MPEP 1002.02(c) within two months of the date of the official action. The applicants believe no fee is due with this petition. However, the commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 13-2855.

The present application was filed on April 8, 2004 with 11 claims, claims 1 and 9 being independent claims. The application claims direct priority from International Application No. PCT/DE02/03760, filed on October 7, 2002, which in turn claims convention priority from German Patent Application No. 101 49 622.2, filed on October 9, 2001. On September 20, 2005, a first non-final official action rejected claims 1-11, *inter alia*, as being unpatentable over U.S. Patent No. 5,774,053 to Porter (hereinafter "Porter") in view of U.S. Patent No. 6,456,900 to Kakuta under 35 U.S.C. § 103(a). The claim for foreign priority

Appl. No. 10/820,586

Petition To Withdraw Holding Of Finality Of Final Rejection Dated June 26, 2006

AUG 25 2006

under 35 U.S.C. § 119 and the receipt of the certified copies of the priority documents were acknowledged in the Office Action Summary. In response, on December 20, 2005, the applicants filed an "AMENDMENT 'A'" canceling claims 1-11 and adding claims 12-20, with claims 12 and 13 being the independent claims.

A second final official action was mailed on March 9, 2006 rejecting claims 12-20, *inter alia*, under 35 U.S.C. § 103(a) as being unpatentable over Porter in view of U.S. Patent No. 6,879,243 to Booth et al. (hereinafter "Booth et al."). The claim for foreign priority under 35 U.S.C. § 119 and the receipt of the certified copies of the priority documents were again acknowledged in the Office Action Summary. In response, on May 9, 2006, the applicants traversed the previous rejections by filing an "AMENDMENT 'B' AFTER FINAL REJECTION" demonstrating that Booth et al. was not a proper prior art reference given the applicants' 35 U.S.C. § 119 foreign priority date of October 9, 2001, and enclosing a verified English translation of German Patent Application No. 101 49 622.2. As such, the applicants successfully overcome the rejections under 35 U.S.C. § 103(a) by relying upon their 35 U.S.C. § 119 foreign priority claim and without amending the claims. Claims 12 and 13 were amended in response to rejections under 35 U.S.C. § 112, but claims 12 and 13, and all claims dependent thereon, were not otherwise amended in response to the rejections under 35 U.S.C. § 103(a).

A third final official action was mailed on June 26, 2006 withdrawing the previous rejection, and asserting a new ground(s) of rejection of claims 12-20 under 35 U.S.C. § 103(a) as being unpatentable over Porter in view of newly cited U.S. Patent No. 5,212,644 to Frisch (hereinafter "Frisch").

On August 9 and 10, 2006, the applicants' representative, Aaron M. Peters (Reg. No. 48,801) conducted telephonic interviews with Examiner William Bangachon and the examiner's supervisor, Wendy Garber, during which reconsideration and withdrawal of the holding of finality was requested. The examiner and the examiner's supervisor asserted that the grounds for rejection in the June 26, 2006 third action were not new. The examiner and the examiner's supervisor also asserted that finality was proper because the March 9, 2006 second action was vacated due to the antedated Booth et al. reference, and the June 26, 2006 third action citing a new reference to replace Booth et al. takes the place of the March 9, 2006 second action with the new grounds being necessitated by the May 9, 2006 "AMENDMENT 'A'" in response to the September 20, 2005 first action. Lastly, the examiner and the examiner's supervisor asserted that finality was proper because Frisch could have been cited

Appl. No. 10/820,586

Petition To Withdraw Holding Of Finality Of Final Rejection Dated June 26, 2006

in the March 9, 2006 second action. The examiner acknowledged that the amendments in response to the 35 U.S.C. § 112 rejections did not necessitate the rejections in the June 26, 2006 third action.

The MPEP does not allow a second or any subsequent action to be made final where the examiner introduces a new ground of rejection that was neither necessitated by the applicant's amendment nor based on information submitted by the applicant in an information disclosure statement filed during the period set forth in 35 CFR 1.97(c). The June 26, 2006 third action raises new grounds for rejection, principally rejections based upon newly-cited Frisch. The new rejections were in no way based upon the amendments made by the applicant in response to the 35 U.S.C. § 112 rejections from the March 9, 2006 second action. In fact, each of the new rejections, though ultimately not sustainable, could have been made to the claims prior to the May 9, 2006 "AMENDMENT 'B' AFTER FINAL REJECTION" as each claim included the element to which the examiner objects, and the claim for foreign priority under 35 U.S.C. § 119 was made and already acknowledged. Also, Frisch was not submitted by the applicant in the information disclosure statement filed under 35 CFR 1.97(c). Instead Frisch was submitted by the examiner only in the most recent action.

Although the Examiner and the Examiner's supervisor asserted during the telephonic interview that the grounds for rejection were not new, the June 26, 2006 action actually acknowledges that the rejections are a new ground(s) of rejection (see "Response to Arguments", page 2, paragraph 1), and does not assert that the action is final as necessitated by amendment or IDS (see "Conclusion", page 5, paragraphs 6 and 7). Likewise, the Interview Summary dated August 21, 2006 acknowledges the ground for rejection are new. Further, merely because the rejections in the second and third actions are both based on 35 U.S.C. § 103(a), statutory basis alone does not mean the grounds for rejection are the same. MPEP 2143 requires three criteria to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation to modify or combine a reference(s); (2) there must be a reasonable expectation of success; and (3) a prior art reference(s) must teach or suggest all the claim limitations. If any of the above criteria are not met, a *prima facie* case of obviousness has not been established. In other words, the grounds for rejection are improper. As the applicants successfully argued in the May 9, 2006 "AMENDMENT 'B' AFTER FINAL REJECTION", Booth et al. was not a prior art reference. As such, the March 9, 2006 second action did not establish a proper grounds for rejection because the second action did

Appl. No. 10/820,586

Petition To Withdraw Holding Of Finality Of Final Rejection Dated June 26, 2006

not cite a prior art reference that teaches or suggests all the claims limitations. Again, it is noted that the claim for foreign priority under 35 U.S.C. § 119 and the receipt of the certified copies of the priority documents were acknowledged. Accordingly, any subsequent rejection necessarily has to include new grounds for rejection to correct for the deficiency of the previous grounds for rejection by citing a new prior art reference or combination of references.

Finally, a second or any subsequent action on the merits in any application cannot be made final "if it includes a rejection on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art." MPEP § 706.07(a). Although claims 1-11 were cancelled and claims 12-20 were added in the December 20, 2005 "AMENDMENT 'A'", in the May 9, 2006 "AMENDMENT 'B' AFTER FINAL REJECTION" the applicants did not amend claim 12 or 13, or any claim dependent thereon, in response to the obviousness rejections, yet the final action of June 26, 2006 rejected those claims in reliance on Porter in view of newly-cited Frisch.

Whereas a goal of prosecution is to bring a speedy conclusion and clearly define the issues between the examiner and the applicant, such a goal must be balanced with affording an applicant a full and fair opportunity to address claim rejections without prematurely cutting the applicant off in the prosecution of the application. MPEP § 706.07. This goal is not served if an applicant is consistently subject to final rejections in third or subsequent actions based solely on an amendment following a first action. Inherently, an applicant is faced with greater limitations in responding to a final rejection as compared to responding to a non-final rejection, both in terms of the time to respond, and the arguments or amendments that will be considered. Reasoning that a new ground for rejection based on newly-cited art is necessitated by an amendment that was not made in response to the preceding grounds for rejection does not permit an applicant a full and fair opportunity to assess the grounds for rejection based on newly-cited art, but instead unduly prejudices the applicant.

As such, while the examiner and the examiner's supervisor asserted that the cancellation and addition of claims in the "AMENDMENT 'A'" in response to the first action necessitated the grounds for rejection in the third action, this is a misinterpretation of MPEP 706.07(a). Such an interpretation would allow any second or subsequent action to be made final even if based on newly cited art, regardless of when the amendment were made. An

Appl. No. 10/820,586

Petition To Withdraw Holding Of Finality Of Final Rejection Dated June 26, 2006

amendment in response to a first action can be used as an excuse to necessitate grounds for rejection in *any* subsequent action. In effect, an applicant that successfully overcomes a rejection in a second or subsequent action by removing a reference as prior art, either by argument or antedating, is forever subject to a series of final rejections, regardless of the propriety of each new ground(s) for rejection based on newly-cited references. Such an interpretation does not meet the goals of prosecution.

Instead, a more reasonable interpretation of MPEP 706.07(a) would not allow any second or subsequent action on the merits to be made final if it includes a rejection, based on newly-cited art, of any claim not amended by the applicant in response to the previous action. Rejections may still be made final if the applicant amended the claims in response to the previous action. Such an interpretation still provides a speedy conclusion and clearly defines prosecution issues, because the applicant is still precluded from amending as often as new references or grounds for rejection are presented. MPEP § 706.07. At the same time, if the applicant successfully overcomes the new grounds for rejection without amendment, the applicant is afforded a full and fair opportunity to assess any newly-cited reference from the examiner, without being prejudiced with the limitations of a final rejection.

Regarding the assertion that finality was proper because the March 9, 2006 second action was vacated due to the antedated Booth et al. reference, the acknowledgements of foreign priority demonstrate that the examiner was fully aware that the requirements under 35 U.S.C. § 119 for claiming priority had been fulfilled even before the first action. Further, the MPEP does not appear to provide any basis for making an action final merely because an applicant successfully overcame the previous rejection by antedating a reference based on a claim for foreign priority under 35 U.S.C. § 119, especially where the claim for priority has already been made and the certified copy of the foreign application has already been filed. Likewise, the MPEP does not appear to provide any basis for the assertion that the June 26, 2006 third action may be made final merely because it replaces the March 9, 2006 second action which was final and cites a new reference to replace an antedated reference. In other words, the MPEP does not appear to provide any basis for an exception to MPEP 706.07(a) that allows a subsequent action to be final merely because the previous action was final.

Lastly, while the examiner and the examiner's supervisor also asserted that Frisch *could have* been cited in the March 9, 2006 action instead of Booth et al., such an assertion is merely hypothetical and of no consequence. The fact remains that Frisch was not previously cited in the March 9, 2006 second action. Frisch is a newly-cited reference.

RECEIVED  
CENTRAL FAX CENTER

Appl. No. 10/820,586

Petition To Withdraw Holding Of Finality Of Final Rejection Dated June 26, 2006

AUG 25 2006

In conclusion, as the new grounds of rejection raised in the final official action and based on the newly-cited Frisch reference were not necessitated by applicant's amendment, based on a reference submitted by the applicant, or in response to claims amended by the applicant in the previous response, the finality of the June 26, 2006 action is improper and should be withdrawn. Such withdrawal is respectfully requested.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive  
6300 Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6300

By: \_\_\_\_\_

Aaron M. Peters  
Registration No.: 48,801  
Attorney for Applicants

August 25, 2006